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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,327	11/10/2003	Kiyoaki Mori	AA-547C	5111

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/705,327	Applicant(s) MORI ET AL.	
	Examiner JYOTHSNA A. VENKAT Ph. D	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*M*

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/22/05 has been entered.

Claims 1-11 are pending in the application and the status of the application is as follows:

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. patent 5,750,122 (122) and WO 00/61083('083) and JP 002188044 ('044 abstract).

The instant application is claiming skin care composition and method of controlling sebum and method of making the composition comprising:

- (1) From about 0.01% to about 5% of a carboxylic acid/carboxylate copolymer;*
- (2) From about 0.1% to about 2% of a surfactant system comprising two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ethers having a C12-18 alkyl substitute, polyoxyalkylene hydrogenated castor. Oils, and linear or branched, mono- or tri-alkyl glycerides; from about 0.05% to about 5% of a silicone component;*
- (3) Silicone component*
- (4) From about 0.01% to about 5% of an emollient oil;*
- (5) From about 0.1% to about 10% of a sebum absorbing agent (species is cellulose powder of claims 2-3);*
- (6) From about 1% to about 20% of a water soluble humectant; and*
- (7) An aqueous carrier;*
- (8) Water-soluble polymer (claim 4)*
- (9) Tacky skin treatment agent (claim 5)*
- (10) Sebum suppressing plant extract (claim 6)*
- (11) UV protecting agent (claim 7)*
- (12) Whitening agent (claim 8)*

Patent '122 teaches compositions for treating skin or hair using ingredients 1, 3-4, and 6-12. The patent also teaches under example 21 anti-acne lotion. Anti-acne lotions are used to control excess sebum. Since excess sebum causes acne. See col.3, lines 15-35 for panthenol which is ingredient 9, col.3, lines 40 et seq and col.4, lines 1-15 for ingredient 8, see col.4, lines 52-55 for ingredient 6, see also col.6, lines 40-54 for ingredient 6, see col.6, lines 55 et seq and cols.7 9 for ingredient 3, see col.6, lines 20-37 for ingredient 1, see col.col.9, line 44 for ingredient 12, line 49 for ingredient 11 and col.10, line 20 for ingredient 10 which is witch hazel extract. The patent does not teach specifically ingredient 2 and 4. However, WO '083 teaches micro emulsions using ingredients 2 at page 5 and page 6, lines 1-9, oily component at page 6, page 7 lines 1-24. The WO document also teaches ingredient 8 along with humectants at page 9, lines 2035, page 10, and lines 1-9. The document also teaches actives at paragraph bridging pages 10-11, page 11, lines 10-30, pages 12-13 and at pages 15-16 teaches UV protecting agents in the compositions. The document at page 10 teaches the method of mixing the ingredients. The document or the patent does not teach cellulose powder in the compositions. The JP abstract teaches cellulose powder in cosmetic compositions.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of the patent '122 and add the specific surfactant system and oily component along with UV protecting agents of WO document and add cellulose powder of the JP abstract expecting beneficial effect to the skin. One of ordinary skill in the art would be motivated to combine the ingredients since all the references are drawn to the cosmetic compositions and the idea of combining the ingredients flows logically from the art for having been used in the analogous cosmetic compositions. One of ordinary skill in the art would have

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reasonable expectation of success, since combining the surfactant system and oily component into the compositions of patent '122 has the advantage of providing the consumer moisturizing affect and imparting non-greasy feeling to the consumer and adding the cellulose powder to the composition has the additional advantage of providing to the compositions no coagulation effect caused by electric charge. Absent a showing side by side comparison of example 1 of WO document vs. example 21 vs. instant application composition claims giving unexpected and superior results commensurate with the scope of claims, the claims are rendered prima facie obvious over the combination of the references.

Applicants in the response filed 7/22/05 argue that the claims have been amended to specify that that the viscosity of the compositions prior to applying shear is from about 100 to about 6,000mPs.s and when the compositions of the present invention have a viscosity in this range, the compositions exhibit the shear-thinning that is not taught in the cited art.

In response to the above argument, claim 1 drawn to the compositions have been amended and not claim 9 drawn to the method of making the compositions. Applicants did not present evidence with respect to the criticality of having viscosity before applying shear.

Applicants also argue that the compositions of patent '122 are to emulsions and provide no indication of transparency and point out that example 21 of the patent contains stearyl alcohol, cetyl alcohol, stearic acid- 100 and distearyl dimethylammoniumchloride and in applicant's experience such compositions would not result in a transparent emulsion under normal mixing conditions.

In response to the above argument, the expression " comprising" permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even

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in major amounts. Moleculon Research corp., v. CBS, Inc., 793 F. 2d 1261, 229 USPQ 805 (FED. Cir. 1986); In re Baxter, 656 F. 2d 679, 210 USPQ 795, 803 (CCPA 1981). Applicants did not present side-by-side comparison of example 21 vs. instant application which demonstrated that example 21 is not transparent.

*Clarification is requested for the following statement in the specification since claim 3 is drawn to cellulose powder and applicants argue that the compositions are transparent using examples 7-9.*

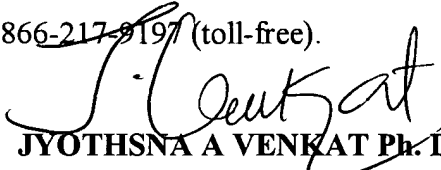
*“Examples 7 through 9 are made by using the same compositions of Examples 1, 2, and 4, respectively, but lacking the cellulose powder. Examples 10 through 12 are made by using the same compositions of Examples 3, 5, and 6, respectively, but lacking the vinydimethicone/methicone silsesquioxane. Examples 7 through 12 have a transparent appearance, and an absorbance of no more than about 2 at a wave length of 340nm”.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JYOTHSNA A VENKAT Ph. D**  
**Primary Examiner**  
**Art Unit 1615**

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